UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/694,311
Filing Date: October 27, 2003
Appellant(s): DAVIS, TOMMY L.

—————————————
Christopher J. Rourk
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 3, 2008 appealing from the

Office action mailed April 2, 2008

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

U.S. Patent, **5,963,134**, Bowers et al

U.S. Patent, **5,380,047**, Molee et al.

U.S. Patent, **5,732,401**, Conway

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims: The

ground(s) for rejection are reproduced below from the final Office Action and are

provided here for the convenience of both Appellant and The Board of Patent Appeals:

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.   Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

   a.   The "means for receiving owner registration data and item data" as recited

         in claim 15.

   b.   The "means for determining whether the item matches stored item data"

         as recited in claim 15.

   c.   The "means for storing the owner registration data as an authenticated

         owner registration data" as recited in claim 15.

   d.   The "means for determining whether the item data matches stored item

         data" as recited in claim 16.

   e.   In Claim 15, the specification does not clearly link the corresponding

         structure to:

   i. The "means for receiving owner registration data and item data."

   ii. The "means for determinant whether the item data matches stored item data."

   iii. The "means for storing the owner registration data as authenticated owner registration data."

  f. In Claim 16, the specification does not clearly link the corresponding structure to:

   iv. The "means for determining whether the item data matches stored item data."

"Failure to describe adequately the necessary structure, material, or acts corresponding to a means-plus-function limitation in the written description means that the drafter has failed to comply with Section 112, Para. 2." *Atmel Corp. v. Information Storage Devices, Inc.,* 198 F.3d 1374, 1380, 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) citing *In re Dossel,* 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 fled. Cir. 1997)).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. As per claims 15 and 16, the system contains software (data) structures not claimed as embodied in computer-readable media and therefore are descriptive material *per se* and are not statutory because they are not capable of causing function change in a computer. See *In re Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1 and 4 – 20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowers et al. (5,963,134).**

As per claim 1, Bowers discloses, a system for tracking an authenticated item comprising:

an authentication device affixed to the item ([abstract]; uses RFID tags attached to each article);

an item registration system receiving authentication device data from the authentication device and associated item data and storing the authentication device data and the associated item data (col. 2, lines 16 – 19; via the identification information stored in the integrated circuit of an interrogated tag; and a database for receiving the

interrogator output signals); and

an owner registration system receiving owner registration data after a buyer has acquired the item (col. 3, lines 30 – 34; via the database receives the patron identification information and the article identification information for each of the articles to be borrowed. The patron is construed as the buyer); and

a buyer verification system receiving the authentication device data, the associated item data and the owner registration data and storing buyer verified data if the associated item data correlates to the owner registration data (col. 11, lines 17 – 22; the patron may directly identify himself or herself to the system 50 by entering an ID and/or password into the computer terminal 52. The patron ID data is received by the computer terminal 52, which communicates with a database of patrons stored in the computer 48 to verify that the patron is authorized to check out articles 22).

As per claim 4, Bowers discloses, wherein the item registration system further comprises:

an item check-out system receiving item check-out data for the item when it is removed from inventory for use (col. 2, lines 18 – 21; via the database including inventory data for articles monitored by the system including checkout status data);

an item check-in system receiving item check-in data for the item when it is returned to inventory from use (col. 4, lines 27 – 29; via the inventory database receives

the interrogator output signals and updates the checkout status data of the article being

returned therewith); and

an event verification system providing event verification data associated with the

item while it was in use (col. 20, lines 58 – 62; via the first interrogator receiving a

response signal containing the stored article identification information for the article to

be removed; a processor in communication with the first interrogator and the database).

As per claim 5, Bowers discloses, wherein the purchaser verification system

further comprises a chain of custody system receiving purchase location data and

determining whether chain of custody data exists for the item that ends at the purchase

location (col. 1, lines 30 – 32; The database receives the patron identification

information and the article identification information for each of the articles to be

borrowed) (col. 4, lines 11 – 15; and updating the inventory database with the circulation

status of the article to be removed) (FIG. 8 is a sample historical usage report 136).

As per claim 6, Bowers discloses, further comprising an alert system generating

an alert to an operator if the associated item data does not correlate to the owner

registration data (col. 5, lines 43 – 45; wherein the zone interrogator activates an alarm

in response to the detection of the removal of an article from the predefined area).

As per claim 7, Bowers discloses, further comprising an item transfer system

receiving purchaser data from an owner and requesting confirmation from a purchaser

based on the purchaser data (col. 4, lines 52 - 57; via a processor in communication

with the first interrogator and the database, the processor receiving the patron

identification information and the article identification information for the article to be

removed from the first interrogator, and updating the inventory database with the

circulation status of the article to be removed).

As per claim 8, Bowers discloses, further comprising a personage verification

system receiving personage data and providing item data that corresponds to the

personage data (col. 4, lines 43 – 44; a patron identification device for identifying a

patron to the system).

As per claim 9, Bowers discloses, a method for tracking an authenticated item

comprising:

affixing an authentication device to the item (col. 2, lines 1 – 2; Each of the

articles has an RFID tag attached thereto);

storing authentication device data and item description data (col. 2, lines 4 – 5;

the tag also includes an integrated circuit connected to the antenna for storing article

identification information);

receiving owner registration data (col. 3, lines 24 – 26; the interrogator receives a

response signal containing the stored article identification information for each of the

articles to be borrowed and patron identification information from the ID card); and

generating confirmation data if the owner registration data and the item

description data are correlated to the authentication device data (col. 17, lines 31 – 34;

if the patron borrows an item from a multi-media lab, the patron's RFID card and the

article's jacket or holder (which is tagged) would be read and associated with each

other).

As per claim 10, Bowers discloses, further comprising generating alert data if

the owner registration data and the item description data are not correlated to the

authentication device data (col. 12, lines 10 – 12; If an article 22 is not properly checked

out, a visible and/or audio alarm is triggered to alert the patron and library employees to

the problem).

As per claim 11, Bowers discloses, wherein affixing the authentication device to

the item comprises affixing a radio frequency identification tag to the item (col. 2, lines 1

– 2; Each of the articles has an RFID tag attached thereto).

As per claim 12, Bowers discloses, wherein generating confirmation data if the

owner registration data and the item description data are correlated to the

authentication device data comprises determining whether item description data

provided with the owner registration data matches item description data associated with

the authentication device data (col. 20, lines 38 – 40; the processor receiving an output

signal from the exit interrogator including the identification information of the response

signal, wherein the processor compares the received identification information with the

information stored in the database to determine whether the article is recorded therein

as checked out).

As per claim 13, Bowers discloses, further comprising:

receiving personage data associated with the item (col. 4, lines 43 – 44; a patron

identification device for identifying a patron to the system); and

generating a report that includes the item data based on the personage data.

(col. 4, lines 10 – 15; the processor receiving the patron identification information

and the article identification information for the article to be removed from the first

interrogator, and updating the inventory database with the circulation status of the

article to be removed).

As per claim 14, Bowers discloses, further comprising:

receiving item transfer data from a current owner (col. 11, lines 28 – 32; via he

patron manipulates either the article 22 to be checked out and/or the fixed interrogator

43 or scanner 42 so as to interrogate the tag 54 associated with the article 22 and read

the data returned by the tag 54);

receiving transfer confirmation data from a prospective owner (col. 1, lines 36 –

39; via the tag serial number is sent directly, or through the computer terminal 52, to the

computer 48 which locates the appropriate record for the article 22 in its database 66)

(col. 12, lines 3 – 6; via to ensure that only articles 22 which were properly checked out

are removed from the library 10, the pair of smart pedestals 36 (which incorporates the elements of the interrogator 100 of FIG. 3 therein) interrogates the articles 22 as they pass through a zone in which a patron or employee must pass through to exit the library 10.); and

storing the prospective owner data as the owner registration data after receiving the transfer confirmation data. (col. 11, lines 40 – 42; via the database 66 is then updated to show that the article 22 has been checked out to the patron currently using the station 50).

As per claim 15, Bowers discloses, a system for authenticating an item comprising:

means for receiving owner registration data and item data (col. 11, lines 7 – 12; via when a patron wishes to check out an article 22 from the library collection, the patron identifies himself or herself to the system through a patron identification (ID) device 68. The patron ID device 68 may be a card reader, such as a bar code reader or magnetic stripe reader for reading data from a patron's library card. The patron ID device 68 may also be the same fixed interrogator 43 or RFID scanner 42 used for interrogating articles 22.);

means for determining whether the item data matches stored item data (col. 2, lines 16 – 19; via the identification information stored in the integrated circuit of an interrogated tag; and a database for receiving the interrogator output signals); and

Means for storing the owner registration data as authenticated owner registration data (col. 11, 19 – 27; via the patron ID data is received by the computer terminal 52 which communicates with a database of patrons stored in the computer 48 to verify that the patron is authorized to check out articles 22. If the patron is not in the patron database or if the patron is delinquent, the checkout procedure may be either terminated or the computer terminal may enter a patron registration routine. After the patron is identified and determined to be an authorized user, the checkout process may begin by performing the following steps).

As per claim 16, Bowers discloses, wherein the means for determining whether the item data matches stored item data further comprises an item identification system receiving authentication device data from an authentication device attached to the item and storing the authentication device data as the item data (col. 2, lines 2 – 8; via each of the articles has an RFID tag attached thereto. Each tag includes an antenna for use in detecting the presence of the article by receiving an interrogation signal and returning a response signal. The tag also includes an integrated circuit connected to the antenna for storing article identification information and for outputting the article identification information with the response signal upon interrogation of the tag).

As per claim 17, Bowers discloses, further comprising an authentication device attached to the item in a manner that allows the authentication device to be read by an authentication device reader and that generates an indication if the authentication

device is removed from the item (col. 21, lines 62 – 63; via the system according to
claim 13 wherein the tag is a physically non-deactivatable tag).

As per claim 18, Bowers discloses, further comprising an owner flagging system
receiving flag data for the item and generating item transfer data (col. 10, lines 35 – 38;
via item identification information may also include any part of the bibliographic data,
such as title, author, publisher and the like. optionally, the database record may include
additional information, such as a predetermined location of a large library system where
the article 22 is stored, which is understood as intended to facilitate the borrowing of the
articles.)

As per claim 19, Bowers discloses, further comprising a buyer identification
system receiving buyer identification data and generating buyer transfer query data (col.
3, lines 30 – 34; via the database receives the patron identification information and the
article identification information for each of the articles to be borrowed).

As per claim 20, Bowers discloses, further comprising a buyer verification
system receiving buyer transfer confirmation data and changing the owner registration
data to the buyer identification data (col. 11, lines 40 – 42; The database 66 is then
updated to show that the article 22 has been checked out to the patron currently using
the station 50).

As per claim 22, Bowers discloses, further comprising a tracking personalization

system receiving item data and associating the item data with a personalization

database ([abstract]; via an inventory database tracks all of the tagged articles and

maintains circulation status information for each article).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

> 1.   Determining the scope and contents of the prior art.
> 2.   Ascertaining the differences between the prior art and the claims at issue.
> 3.   Resolving the level of ordinary skill in the pertinent art.
> 4.   Considering objective evidence present in the application indicating
>   obviousness or nonobviousness.

5.   **Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over Bowers et. al. (5,963,134) in view of Molee et al. (5,380,047).

As per claim 2, Bowers discloses, wherein the authentication device comprises:

a radio frequency identification tag having a unique identifier ([abstract]; via using

RFID tags attached to each article. Each tag has a unique identification or serial number

for identifying the individual article).

However, Bowers fails to disclose a metallic tag having a hologram etched upon

a surface and a peel-away adhesive layer affixed to the radio frequency identification

tag and the metallic tag, wherein a portion of the peel-away adhesive layer remains

affixed to the item if the authentication device is removed from the item.

Molee teaches a metallic tag having a hologram etched upon a surface (col. 2,

lines 17 – 20; Through the use of a tamper proof hologram, the hologram 14 cannot be

removed or copied without at east partially destroying the hologram);

and a peel-away adhesive layer affixed to the radio frequency identification tag

and the metallic tag, wherein a portion of the peel-away adhesive layer remains affixed

to the item if the authentication device is removed from the item (col. 2, lines 19 –22;

These tamper proof holograms are well known and comprise a hologram on a substrate

with an overlying clear film).

From this teaching of Molee, it would have been obvious to one of ordinary skill

in the art at the time the invention was made to modify the authentication device of

Bowers to include the hologram and peel-away adhesive layer taught by Molee in order

to ensure an article is genuine and prevent the device from being tampered with.

As per claim 3, Bowers teaches, wherein the radio frequency identification tag,

such that the radio frequency identification tag remains affixed to the item if the

authentication device is removed from the item ([abstract]; via using RFID tags attached to each article. Each tag has a unique identification or serial number for identifying the individual article).

However, Bowers fails to explicitly disclose being affixed to the peel-away adhesive layer and is separate from the metallic tag.

Molee teaches affixed to the peel-away adhesive layer and is separate from the metallic tag (col. 2, lines 19 – 22; These tamper proof holograms are well known and comprise a hologram on a substrate with an overlying clear film).

From this teaching of Molee, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the authentification device of Bowers to include the peel-away adhesive layer, separate from the metallic tag, in order to facilitate check-in/checkout, inventorying, and theft control of articles.

7.   **Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers et. al. (5,963,134) in view of Conway (5,732,401).**

As per claim 21, Bowers discloses all the elements of the claimed invention, but fails to explicity disclose, further comprising an item appraisal system receiving item appraisal data and associating the item appraisal data with item data.

Conway teaches, further comprising an item appraisal system receiving item appraisal data and associating the item appraisal data with item data (col. 2, lines 57 – 59; via costs may be tracked on a per-use or per-activity basis, or on a time basis, or

both, whichever is the most accurate measure of the costs of personnel and/or

equipment).

From this teaching of Conway, it would have been obvious to one of ordinary skill

in the art at the time the invention was made to modify the system for tracking

authenticated items of Bowers to include the appraisal system of Conway in order to

establish profitable pricing.

(10) Response to Argument

1.   The Appellant presents arguments (Brief, page 9) in an attempt to demonstrate that the objection of the specification presented in the final rejection was improper.

The Examiner notes, under 37 CFR 41.31(a)(1), an applicant for a patent dissatisfied with the primary examiner's decision in a second <u>rejection</u> of his or her claims may appeal to the Board for review of the examiner's <u>rejection</u> by filing a notice of appeal and the required fee set forth in 37 CFR 41.20(b)(1) within the time period provided under 37 CFR 1.134 and 1.136.

The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences, while an objection, if persisted, may be reviewed only by way of petition to the Director of the USPTO. Therefore the Appellant's arguments presented with respect to the specification objection are consider moot.

2.   The Appellant argues (brief, page 2) that claims 15 and 16 comply with 35 U.S.C. 112(2), stating that the structure corresponding to the claimed means plus function elements is shown in the specification and drawings.

The Examiner notes in response to Appellant's argument that the specification does not clearly link the corresponding structure to the "means for receiving owner registration data and item data," "means for determinant whether the item data matches stored item data," "means for storing the owner registration data as authenticated owner

registration data," and the "means for determining whether the item data matches stored

item data."

"Failure to describe adequately the necessary structure, material, or acts

corresponding to a means-plus-function limitation in the written description means that

the drafter has failed to comply with Section 112, Para. 2." Atmel Corp. v. Information

Storage Devices, Inc., 198 F.3d 1374, 1380, 53 USPQ2d 1225, 1229 (Fed. Cir. 1999)

citing In re Dossel, 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 fled. Cir. 1997)).

Therefore, the Examiner respectfully disagrees.

3.   The Appellant argues (brief page 10) against the 35 U.S.C. 101 rejection

and states that the Examiner apparently fabricated a standard which has no relationship

to the controlling law of UMS Gaming and progeny.

However, in [0021] of the specification, it states, "System 100 includes item

registration system 102, which can be implemented in hardware, software or a suitable

combination of hardware and software and which can be one or more software systems

operating on a general purpose server platform."

The "means for" the steps in claims 15 and 16 violate 35 U.S.C. 101 because

they state "software or any suitable combination of hardware and software." This

recitation of "software" violates 35 U.S.C. 101. Furthermore, the broadest reasonable

interpretation could consist of nothing more than software, therefore the Examiner

respectfully disagrees.

4.   The Appellant argues (Brief, page 10) that the construction of the claims adopted by the Examiner is incorrect, and is used to improperly reject the claims. consider claim 1, which includes an owner registration system receiving owner registration data after a buyer has acquired the item. In the Office action mailed April 2, 2008 at page 5, the Examiner construes "buyer" to be a patron of Bowers that is borrowing an item. This is an unreasonable construction on its face. The purpose of the system of Bowers is to track articles that are loaned, so that the patron that has borrowed the article can be identified, as that patron is under an obligation to return the item that has been borrowed. In contrast, when a buyer purchases an article, they are free to do anything they want with it, and are under no obligation to return it. As such, Bowers fails to disclose the owner registration system receiving owner registration data after the buyer has acquired the item.

The Examiner notes, in response to Appellant's argument that the titles given to the system such as "buyer' and "owner" do not functionally affect the outcome of the system. The "patron" of Bowers as referenced in (col. 11, lines 17 – 22) is construed as the "buyer" of the claimed invention and the library itself is construed as the "owner" of the claimed system. Although the patron is under obligation to return the item that has been borrowed, it does not functionally affect the initial transaction of the transfer of possession. Therefore, the "owner registration system receiving owner registration data after the buyer has acquired the item" is met by (col. 3, lines 30 – 34) by the database

that stores the patron (which is construed as the "buyer") identification information for

articles to be borrowed.

The Appellant argues (Brief, page 10) that likewise, Bowers fails to disclose a

buyer verification system receiving the authentication device data, the associated item

data and the owner registration data and storing buyer verified data if the associated

item data correlates to the owner registration data. At page 6 of the Office action mailed

April 2, 2008, the Examiner states that the "patron ID is received by the computer

terminal 52, which communicates with a database of patrons stored in the computer 48

to verify that the patron is authorized to check out articles 22." Thus, there are two

parties involved in the claim, an owner and a buyer, whereas in Bowers there is only a

single party, the patron. Either the patron of Bowers is stored in the database of

patrons, and can thus borrow an article, or they are not, and thus cannot borrow an

article.

The Examiner notes, in response to Appellant's argument, as stated above, that

the "buyer" of the claimed invention is construed as the "patron" of Bowers, and the

"owner" of the claimed system is construed as the library itself. Therefore, there are in

fact two parties interacting in Bowers.

The Appellant argues (Brief, page 10) that The a buyer verification system

receives the authentication device data, the associated item data and the owner

registration data and stores buyer verified data if the associated item data correlates to

the owner registration data. In one exemplary embodiment, this allows buyers to purchase an item from an owner after it has been verified that the owner actually owns the item. Again, Bowers does not deal with transfer of ownership, and the patron of Bowers never takes ownership of any items. As such, there is no way for Bowers to receive owner registration data or store buyer verified data.

The Examiner notes, in response to Appellant's argument, that the "buyer verification system receiving the authentication data, the associated item data and the owner registration data and storing buyer verified data if the associated item data correlates to the owner registration data" is met in Bowers by (col. 11, lines 17 - 22) where the "patron" of Bowers directly enters an ID and or password into the computer terminal, which is construed as the "buyer verified data", "the associated item data", which is the book tag information, "the owner registration data", which is the library ownership information. The transfer of ownership occurs when the patron checks out the book and it is in the possession of the patron. Borrowing is construed as temporary ownership. Although the patron is required to return the article, it does not functionally affect the system. Therefore, the Examiner respectfully disagrees.

The Appellant argues (Brief, page 11) that Bowers simply fails to provide event verification data associated with the item while it was in use.

The Examiner notes, in response to Appellant's argument, that the specification defines an "event" as being open ended. In [0040] it states "a sporting event, concert, or

other suitable event." Therefore, fig. 8, which states "number of times placed in interior

book drop" could be construed as events, therefore event verification data.

The Appellant argues (Brief, pages 11 & 12) that there is no chain of custody

data for items that ends at purchase location in Bowers. As discussed, library books are

borrowed, not purchased, and it is unreasonable to construe borrowing a book as

purchasing the book. As such, there is no purchase location. Furthermore, the chain of

custody of a borrowed book starts and ends at the same location. The purchase

location data is entirely missing from Bowers, because it is irrelevant. Locations of

books within the library are tracked by the system of Bowers, but that is for inventory

management, not chain of custody.

The Examiner notes, in response to Appellant's argument again that the role

"borrowing" being construed as "purchasing" does not functionally affect the outcome of

the system. Fig. 8 depicts a historical usage report which encompasses a chain of

custody data. Therefore, the record of patrons who have possessed the books are

recorded as a chain of custody which are distinct individuals who have possessed the

item. The "purchase location" is construed as the "location" in fig. 4, or the library itself,

because this would be the location all transactions occur.

The Appellant argues (Brief, page 12) that no reasonable construction of claim 6

could read on a zone interrogator. In one exemplary embodiment, claim 6 would

generate an alert if" a seller was trying to sell an item that they are not the owner of.

Items leaving zones are completely unrelated, and are instead used to see if an item

has been checked out before it is allowed to leave with a patron.

The Examiner notes, in response to Appellant's argument that the item has a

status of owner registration in the system while it is contained within the zone. When the

item is removed without the data being updated as checked out by the patron, the

owner registration data does not correlate and the alert is generated. Therefore the

Examiner respectfully disagrees.

The Appellant argues (Brief, page 12) that there are two parties involved in the

claim, a purchaser and an owner, and there is simply no need for a library book check

out system to request confirmation from a purchaser. Even if "purchaser" was

improperly construed to encompass a library patron that is only borrowing a book, the

patron walks up to a desk with the book and it is checked out to the patron. No

confirmation is requested from the patron.

The Examiner notes that the cited section discloses the "receiving transfer

confirmation data." of the claimed invention. In col. 11, lines 40 – 42 of Bowers, it states

"the database 66 is then updated to show that the article 22 has been checked out to

the patron currently using the station 50." The Examiner notes that the section of

Bowers discloses the "storing the prospective owner data as the owner registration data

after receiving the transfer confirmation data" claim limitation.

The Appellant argues (Brief, page 13) that the use of different terms creates a presumption of different meanings. The patron of Bowers, according to the Examiner, is the owner, the purchaser and the personage!

The Examiner notes, in response to Appellant's argument that "the owner" is construed as the library itself and "the purchaser" is construed as the patron. In the specification, [0038] discloses that "personage verification system 208 can include a password, a user ID for the personage and other suitable data. The definition of patronage data in the specification is open-ended. Therefore, and the "personage data" is construed to be the patron ID or password which is disclosed in Bowers (col. 11, lines 17 - 22).

The Appellant argues (Brief, page 13) that the Examiner cites to col. 17, lines 31-34 of Bowers that disclose associating a patron identifier with a borrowed item, but that is not generating confirmation data if the owner registration data and the item description data are correlated to the authentication device data. In Bowers, a patron (not an owner) is associated with an item using some kind of identification of the item. That is unrelated to what is claimed, in which the confirmation data is generated if the owner registration data and the item description data are correlated to the authentication device data. No confirmation data is generated by Bowers, and a patron ID is associated with an item, no owner registration data and item description data are correlated to the authentication device data.

The Examiner notes that the cited section discloses the "receiving transfer confirmation data." of the claimed invention. In col. 11, lines 40 – 42 of Bowers, it states "the database 66 is then updated to show that the article 22 has been checked out to the patron currently using the station 50." The Examiner notes that the section of Bowers discloses the "storing the prospective owner data as the owner registration data after receiving the transfer confirmation data" claim limitation.

The Appellant argues (Brief, page 13) Bowers does not disclose generating alert data if the owner registration data and the item description data are not correlated to the authentication device data. There is .just a simple flag - item is checked out, or item is not checked out. No correlation to patron data is even disclosed, much less owner registration data.

The Examiner notes, in response to Appellant's argument that the item has a status of owner registration in the system while it is contained within the zone. When the item is removed without the data being updated as checked out by the pa tron, the owner registration data does not correlate and the alert is generated.

The Appellant argues (Brief, page 14) that the Examiner cites to col. 20, lines 38-40 of Bowers, but that is again just the simple flag to see if the item is checked out when the patron leaves with the item. There is simply no determination of whether item description data provided with the owner registration data matches item description data

associated with the authentication device data, which is just common sense to anyone that has ever checked a book out from a library.

The Examiner notes, in response to Appellant's argument that the item has a status of owner registration in the system while it is contained within the zone. When the item is removed without the data being updated as checked out by the patron, the owner registration data does not correlate and the alert is generated. Therefore, the Examiner respectfully disagrees.

The Appellant argues (Brief, page 14) that the Examiner confounds the personage data with the owner registration data, for which there is a legal presumption created by controlling precedent that these are different things.

The Examiner notes, in response to the Appellant's argument that, personage data, as defined by the specification is "[0038] Personage verification system 208 can include a password, a user ID for the personage, and other suitable data" The specification's definition of "personage data" is open ended. Therefore, the Examiner cites col. 4, lines 43 – 44 of Bowers that states "a patron identification device for identifying a patron to the system". Therefore the Examiner respectfully disagrees.

The Appellant argues (Brief, page 14) Claim 14 includes the method of claim 9 further comprising: receiving item transfer data from a current owner; receiving transfer confirmation data from a prospective owner; and storing the prospective owner data as

the owner registration data after receiving the transfer confirmation data. The Examiner

cites to numerous unrelated sections of Bowers dealing with checking items out and

checking items as they pass through a zone detector to see if they are checked out, but

there are no current owners or prospective owners in Bowers. As such, there is simply

no transfer confirmation data from a prospective owner. Again, anyone that has ever

used a library would see why this is inapplicable - when you check a book out from a

library, it is expected that you will return it. You are not the new owner, and the library

expects the book to be returned.

The Examiner notes, in response to Appellant's argument that the titles given to

the system such as "prospective owner" and "current owner" do not functionally affect

the outcome of the system. The "patron" of Bowers as referenced in (col. 12, lines 3 – 6)

is construed as the "prospective owner" of the claimed invention and the library itself is

construed as the "current owner" of the claimed system. Although the patron is under

obligation to return the item that has been borrowed, it does not functionally affect the

transaction of the transfer of possession after the book is checked out and in the

possession of the patron. In col. 12, lines 3 – 6 of Bowers, it states "to ensure that only

articles 22 which were properly checked out are removed from the library 10, the pair of

smart pedestals 36 (which incorporates the elements of the interrogator 100 of FIG. 3

therein) interrogates the articles 22 as they pass through a zone in which a patron or

employee must pass through to exit the library". The Examiner notes that the cited

section discloses the "receiving transfer confirmation data." of the claimed invention. In

col. 11, lines 40 – 42 of Bowers, it states "the database 66 is then updated to show that

the article 22 has been checked out to the patron currently using the station 50." The

Examiner notes that the section of Bowers discloses the "storing the prospective owner

data as the owner registration data after receiving the transfer confirmation data" claim

limitation.

The Appellant argues (Brief, page 13) that although the Examiner cites to

functional descriptive material as allegedly disclosing the corresponding structure to the

claimed means plus function elements, controlling Federal Circuit precedent requires in

"a means-plus- function claim in which the disclosed structure is a computer, or

microprocessor, programmed to carry out an algorithm, the disclosed structure is not

the general purpose computer, but rather the special purpose computer programmed to

perform the disclosed algorithm." WMS Gaming, Inc. v. Int'l Game Technology, 184

F.3d 1339, 1349 (Fed. Cir. 1999). (Emphasis added.) Further recent guidance from the

Federal Circuit confirms that flowchart algorithms and other data structures are the

proper structure for means plus function claims drawn to special purpose computers. In

Allvoice Computing v. Nuance Comm., 504 F.3d 1236, 1245 (Fed. Cir. 2007), flowchart

algorithms such as those in Figure 9 of the pending application were held to provide

sufficient structure for such means plus fiuntion limitations. Of particular relevance, the

data structures and flowchart algorithms reproduced in the Federal Circuit's opinion are

provided here for reference:

In this regard, Bowers is similar to U.S. Patent 6,093,102, recently discussed in

Aristocrat Technologies Australia v. International Gaming Technology (2007-1419)

(Fed. Cir. 2008), where the Federal Circuit held the claims invalid as indefinite under 35 U.S.C. 112(2), as lacking corresponding structure. A review of Bowers reveals that it, too, is utterly lacking in any relevant structure that would apply to the means plus function limitations in the pending claims.

The Appellant argues (brief, page 14) that claims controlling Federal Circuit precedent requires in "a means-plus- function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm." WMA" Gaming, Inc. v. Int'l Game Technology, 184 F.3d 1339, 1349 (Fed. Cir. 1999).

The Examiner notes in response to Appellant's argument that the specification does not clearly link the corresponding structure to the "means for receiving owner registration data and item data," "means for determinant whether the item data matches stored item data," "means for storing the owner registration data as authenticated owner registration data," and the "means for determining whether the item data matches stored item data."

"Failure to describe adequately the necessary structure, material, or acts corresponding to a means-plus-function limitation in the written description means that the drafter has failed to comply with Section 112, Para. 2." Atmel Corp. v. Information Storage Devices, Inc., 198 F.3d 1374, 1380, 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) citing In re Dossel, 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 fled. Cir. 1997)).

Therefore, the Examiner respectfully disagrees.

The Appellant argues (Brief, page 16) Claim 16 includes the system of claim 15 wherein the means for determining whether the item data matches stored item data further comprises an item identification system receiving authentication device data from an authentication device attached to the item and storing the authentication device data as the item data.

The Examiner notes, in response to Appellant's argument that in col. 2, lines 2 – 8 of Bowers, it states "each of the articles has an RFID tag attached thereto. Each tag includes an antenna for use in detecting the presence of the article by receiving an interrogation signal and returning a response signal. The tag also includes an integrated circuit connected to the antenna for storing article identification information and for outputting the article identification information with the response signal upon interrogation of the tag." The Examiner notes that the cited sections of the prior art meet the claim limitation of "means for determining."

The Appellant argues (Brief, page 16) that the Examiner construes this as a "physically non-deactivatable tag," but again, the plain meaning of the claim language excludes any construction that would cover the materials cited by the Examiner.

The Examiner notes, in response to Appellant's argument that the claim states, "an authentication device attached to the item in a manner that allows the authentication device to be read by an authentication device reader and that generates an indication if the authentication device is removed from the item."

Bowers discloses "the interrogator receives the response signals regardless of the orientation of the articles" in col. 3, lines 25 – 30; which allows the authentication device to be read by an authentication device reader, and if the authentication device is removed from the item, then it would be physically evident from the absence of the device which was initially present. Therefore, the Examiner respectfully disagrees.

The Appellant argues (Brief, page 17) that the plain meaning of the claim language excludes any construction that would cover the materials cited by the Examiner.

The Examiner notes, in response to Appellant's argument, as stated above, that the titles given to the system such as "buyer' and "owner" do not functionally affect the outcome of the system. The "patron" of Bowers as referenced in (col. 11, lines 17 – 22) is construed as the "buyer" of the claimed invention and the library itself is construed as the "owner" of the claimed system. Although the patron is under obligation to return the item that has been borrowed, it does not functionally affect the initial transaction of the transfer of possession. Therefore, the Examiner respectfully disagrees.

The Appellant argues (Brief, page 17) that the term personalization database is being equated with claim terms such as item registration system, an owner registration system, and a buyer verification system receiving, contrary to the presumption that different terms connote different meanings.

The Examiner notes, in response to Appellant's argument that in paragraph [0030] of the specification, it states, "Tracking personalization system 124 allows a user to create a personalized tracking portal. In one exemplary embodiment, a user can use tracking personalization system 124 to track household items, such as by applying a tag 106 to items in the household or using other suitable data already affixed to the item such as a bar code or product registration number." In the abstract of Bowers, it states, "An article inventory control system for articles, such as books, uses RFID tags attached to each article. Each tag has a unique identification or serial number for identifying the individual article. An inventory database tracks all of the tagged articles and maintains circulation status information for each article." The Examiner believes that the sections in the Bowers abstract meet the claim limitations.

5.   The Appellant argues (Brief, page 17) that nothing in Molee discloses a portion of the peel-away adhesive layer remains affixed to the item if the authentication device is removed from the item. Molee does disclose that removal of the hologram destroys the hologram, but fails to disclose that a portion of the peel-away adhesive layer remains affixed to the item if the authentication device is removed from the item.

The Examiner notes in response to Appellant's argument that Molee states in col. 2, lines 19 –22; "These tamper proof holograms are well known and comprise a hologram on a substrate with an overlying clear film." The hologram is tamper proof, which is construed as meeting the claim limitation, therefore the Examiner respectfully disagrees.

The Appellant argues (Brief, page 17) that Molee fails to disclose that anything remains affixed to the item when the hologram is removed, just that the hologram is destroyed.

The Examiner notes in response to Appellant's argument that Molee states in col. 2, lines 19 –22; "These tamper proof holograms are well known and comprise a hologram on a substrate with an overlying clear film." The hologram is tamper proof, which is construed as meeting the claim limitation, therefore the Examiner respectfully disagrees.

6.   The Appellant argues (Brief, page 18) that Conway merely teaches activity based cost tracking, not item appraisal. The costs associated with a tracked item have no relationship to the appraised value of an item.

The Examiner notes, in response to Appellant's argument that, an "appraisal" is defined by www.dictionary.com an estimate of value, as for sale, assessment, or taxation; valuation. The Examiner notes that the section of Conway cited, "col. 2, lines 57 – 59; via costs may be tracked on a per-use or per-activity basis, or on a time basis,

or both, whichever is the most accurate measure of the costs of personnel and/or

equipment," fits the definition of an appraisal, because tracking costs is a method of

estimating value. Therefore, the Examiner respectfully disagrees.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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